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Paper No. 24

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**MAR 29 2005**

In re Application	:	OFFICE OF PETITIONS
Peyman et al.	:	
Application No. 09/832,269	:	DECISION ON APPLICATION
Filed: April 10, 2001	:	FOR
Attorney Docket No. 3614/174	:	PATENT TERM ADJUSTMENT
	:	

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)," filed June 21, 2004. Applicants disclose that the initial Determination of Patent Term Adjustment under 35 U.S.C. 154(b) should be corrected from ninety-two (92) days to eighty-two (82) days.

The application for patent term adjustment is **GRANTED** to the extent indicated herein.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is **twenty-two (22)** days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

**BACKGROUND**

On March 18, 2004, the Office mailed a Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. Applicants were advised that the patent term adjustment to date is 92 days.

Applicants timely filed the instant request for reconsideration of the patent term adjustment along with payment of the fee set forth in 37 C.F.R. § 1.18(e)<sup>1</sup>. Applicants request that the patent term adjustment be corrected to 82 days. Applicants stated that an additional period of adjustment of 60 days for delay in taking action in response to their response filed November 8, 2002 should be entered. Specifically, applicants argue that this adjustment would be for the difference between the 4 month date, March 8, 2003, and the date of mailing of the supplemental notice of allowance, May 7, 2003. The supplemental notice of allowance was mailed to correct an earlier notice of allowance mailed March 9, 2003. However, applicants disclose

<sup>1</sup> PALM records indicate that the Issue Fee was also received June 21, 2004.

that the period of adjustment should have been reduced by 66 days pursuant to § 1.704(c)(10) for the filing of a petition to withdraw from issue on July 7, 2003, which was granted on July 7, 2003; and a preliminary amendment on July 21, 2003 and a supplemental information disclosure statement on August 8, 2003, which were both responded to by a notice of allowance mailed on September 11, 2003. Further, applicants disclose that a period of reduction of 4 days should be entered for their delay in paying the issue fee. The Office did not receive the issue fee payment until December 15, 2003, three months and 4 days after the mailing of the notice of allowance.

Applicants state that the present application is not subject to a terminal disclaimer.

#### RELEVANT STATUTES AND REGULATIONS

35 U.S.C. 154(b)(1)(A)(ii) provides for patent term adjustment:

– Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the Patent and Trademark Office to—

(ii) respond to a reply under section 132, or to an appeal taken under section 134, within 4 months after the date on which the reply was filed or the appeal was taken;

37 C.F.R. § 1.702 provides that:

(a) Failure to take certain actions within specified time frames . Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to:

(2) Respond to a reply under 35 U.S.C. 132 or to an appeal taken under 35 U.S.C. 134 not later than four months after the date on which the reply was filed or the appeal was taken;

37 CFR § 1.703 provides, in pertinent part, that:

(a) The period of adjustment under § 1.702(a) is the sum of the following periods:

(2) The number of days, if any, in the period beginning on the day after the date that is four months after the date a reply under § 1.111 was filed and ending on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first;

#### OPINION

As to entry of an additional period of adjustment of 60 days associated with the mailing of a "second" notice of allowance,

applicants' arguments have been considered but not found persuasive. A review of the record reveals that a notice of allowance under § 151 was mailed on March 7, 2003 in response to and within four months of applicants' filing of a response on November 8, 2002. The notice of allowability accompanying the notice of allowance stated that the allowed claims are 1-21. In response to applicants' letter of March 19, 2003, the Office issued on May 7, 2003 a supplemental notice of allowability stating that the allowed claims are 1-25 (and an examiner's amendment cancelling the word "preventive" in claim 22, line 2). The mailing of this supplemental notice of allowability does not alter the date used in calculation of the period of adjustment pursuant to § 1.703(a)(2). The mailing of a supplemental notice of allowability did not constitute a delay by the Office in the issuance of the patent within the meaning of 35 U.S.C. 154(b).

However, applicants are correct that the patent term adjustment should have been reduced by 66 days pursuant to § 1.704(c)(10) for their filing of multiple papers after the mailing of a notice of allowance. Likewise, applicants are correct that pursuant to § 1.704(b), the patent term adjustment should have been reduced by 4 days for applicants taking in excess of three months to pay the issue fee in response to the notice of allowance mailed September 11, 2003.

#### CONCLUSION

In view thereof, the petition is **GRANTED** to the extent indicated.

The patent term adjustment at the time of the mailing of the notice of allowance is **twenty-two (22)** days (92 days of Office delay reduced by 70 days of applicant delay).

As this letter was submitted advising the Office of an error in Applicants' favor, the Office will not assess the \$200.00 application fee under 37 CFR 1.705(b). The Office thanks applicants for their good faith and candor in bringing this to the attention of the Office. The \$200.00 fee submitted is being refunded to Deposit Account No. 23-1925, as authorized.

The application is being forwarded to the Office of Patent Publication for issuance of the application.

Telephone inquiries regarding this matter should be directed to Senior Petitions Attorney Nancy Johnson at (571) 272-3219.

*Karin Ferriter  
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Office of Deputy Commissioner  
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Enclosure: Copy of REVISED PAIR screen